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| 09/786,903 | 05/09/2001 | Jens Stefan Schneider | 10191/1714 | 7920 |
| 26646 | 7590 | 10/21/2004 | EXAMINER | |
| KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004 | | | OLSEN, KAJ K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1753 | |

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,903

Applicant(s)

SCHNEIDER ET AL.

Examiner

Kaj K Olsen

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to the Appeal Brief

1. In view of the applicant's arguments in the appeal brief, it would appear that the grounds for the rejection needs to be changed and prosecution is hereby reopened. In particular, it now appears that the applicant wishes to have claims 10, 13 and 23 read in a manner that is not what the claims literally state (see discussion below). The issue appears to be no longer whether the claims are enabled for what they actually state (as the examiner had phrased the issue), but rather whether the claims read on what the applicant's believe they read on. The main 112 rejection of the claim is hereby changed from a first paragraph rejection to a second paragraph rejection. Moreover, because the applicant wishes the claims to be read in a manner different from what they are literally stating (again see discussion below), the examiner is also reintroducing a rejection over the prior art that the examiner originally withdrew because it did not read on a literal interpretation of the claimed subject matter. Now that the applicant is urging that the claims be read in a manner contrary to what they actually state, this rejection is now necessary.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 20-22, 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the invention, at the time the application was filed, had possession of the claimed invention: Claim 20 depends from claim 12 and specifies the use of a particular mixed oxide in addition to the metal oxide specified in claim 12. The examiner cannot find any support for the combination of any of the materials of claim 12 with any of the materials of claim 20. Page 8, lines 22-24 appear to state that one could use the materials of claim 20 or the materials of claim 12. There is nothing to suggest that these materials would be utilized in combination.

4. In the appeal brief, applicant merely urges that these claims are allowable for the reasons provided for the enablement rejection of claims 10-29. This doesn't address the issue. The grounds of rejection for these claims are different than the earlier grounds of rejection for claims 10-29. In particular, the rejection of these claims is over new matter not conveyed in the original filed disclosure. That is an entirely different issue than the question of enablement (which has now been switched to indefiniteness). Applicant cannot merely disregard this rejection just because they disagree with the earlier grounds of rejection of claim 10. Applicants evidence this much by how they grouped the claims and grouped the issues.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 10 literally states that the first electrode comprises a metal oxide, a metallic component, and a ceramic component. Nowhere in the claim or in the specification does it suggest that the ceramic component is the metal oxide clearly giving the impression that the

claimed ceramic component is something separate from the metal oxide. Moreover, claim 23 reinforces that conclusion when the claim clearly states that the electrode comprises a metal oxide and a metal component "in addition to the cermet". Hence one reading the claimed subject matter would presume that the metal oxide in claims 10 and 23 and the metal component of claim 13 is something separate from the metallic and ceramic components of claim 10.

8. In applicant's arguments, they urge that as a rule metal oxides are ceramics. This is incorrect. Although metal oxides can be ceramics (and vice versa ceramics can be metal oxides), there is no inherent equivalence between the terms. Metal oxides are often not ceramics (e.g. platinum oxide) and ceramics are often not metal oxides (e.g. silicon nitride). Hence there is no inherent equivalence between these terms that need not be expressly stated. If applicant wishes to have the claim interpreted in that manner, then applicant should clearly state that the ceramic component is the earlier metal oxide in claim 10. In addition, claim 23 also needs to be amended to not give the impression that the specified metals and metal oxides of the claim are something different from the metal and ceramic components of claim 10. Claim 13 should also be amended to not give the impression that it is referring to some additional metal component. The examiner recommends the applicant remove the confusing "and further includes" and change the reference to "a metal component" to --the metallic component--. Claim 23 should also refer to --the metallic component-- instead of the "a metal component".

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 10, 12, 13, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima et al (USP 4,720,335). The claims were previously rejected over this reference. This rejection was withdrawn when applicant amended the claims (see the final rejection). However, now that the applicant urges that the claims should be read in a manner that doesn't literally read on the claimed subject, the examiner is reintroducing this rejection.
11. Fukushima discloses a first measuring electrode 2 having a composition comprising manganese oxide and Ag, a solid electrolyte 1 and an inner second electrode 3 that can be regarded as a "second measuring electrode" giving the claim language its broadest reasonable interpretation. See col. 5, lines 10-36 and example 2 in col. 6. Because Fukushima teaches the same combination of metal and metal oxide as the instant invention (see claims 12, 13, and 23), it inherent meets the claim requirement of "having substantially no catalytic effect on an establishment of equilibrium". With respect to claim 19, these are drawn to the intended use of the apparatus and the intended use need not be given further due consideration in determining patentability.

Allowable Subject Matter

12. Claims 11, 14-18, 24, 25, 27 and 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The examiner can normally be reached on Monday through Thursday from 5:30 A.M. to 3:00 P.M. and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AU 1753
October 20, 2004


KAJ K. OLSEN
PRIMARY EXAMINER